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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI MIKITANI, SHINNOSUKIE HONJO,
and TOMOMI HATANOU

Appeal 2010-012494
Application 09/653,163
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE[1]

Hiroshi Mikitani, Shinnosukie Honjo, and Tomomi Hatanou (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-4, 6, 8-13, and 16-26, the only claims pending in the application on appeal. We have jurisdiction pursuant to 35 U.S.C. § 6(b). Arguments were presented orally on February 22, 2012.

Appellants claim a lottery system in which the results of the lottery system are interactively identifiable (Spec. 1:3-5). An understanding of the claimed invention can be derived from a reading of exemplary claim 1, reproduced below [bracketed matter and some paragraphing added].

1. A lottery system utilizing an electronic mail, comprising:

[1] storing means

for storing information of customers;

[2] means for limiting the customers stored in the storing means in advance

so as to specify particular participants for a lottery;

[3] means for uniquely allocating a reply electronic mail address to each of said specified participants,

so that said reply electronic mail addresses are different from each other;

[4] means for sending a first electronic mail to each of said participants,

in which the reply electronic mail address is affixed

as a unique access key to each of said participants;

[5] means for recognizing an application for the lottery from each of said participants

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[1] We refer to Appellants' Appeal Brief ("App. Br.," filed April 9, 2009) and Reply Brief ("Reply Br.," filed August 24, 2010), and the Examiner's Answer ("Ans.," mailed June 28, 2010).

by receiving a second electronic mail sent back to said reply electronic mail address; and

[6] means for notifying each one of said participants who sent back the second electronic mail to the reply electronic mail address of the result of said lottery.

The Examiner relies upon the following prior art:

Wendkos	US 5,983,196	Nov. 9, 1999
Sarno	US 6,024,641	Feb. 15, 2000
Libby	US 6,193,605 B1	Feb. 27, 2001
Strandberg	US 2002/0161589 A1	Oct. 31, 2002

The Examiner rejected the claims as follows:

Claims 1, 10, 17, and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter that Appellants regard as the invention.

Claims 1-4, 6, 8-13, and 16-22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Strandberg and Wendkos.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Strandberg, Wendkos and Sarno.

Claims 23-26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Strandberg, Wendkos and Libby.

ISSUES

The issues of definiteness turn primarily on whether there is support for the means plus function limitations. The issues of obviousness turn primarily on whether the prior art shows individual return email addresses and URLs for all lottery participants to send their submissions to, and whether the claims require these.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Facts Related to the Prior Art

01. None of the references describe sending a first electronic mail to each of said participants, in which the reply electronic mail address is affixed as a unique access key to each of said participants.

02. None of the references describe means for uniquely allocating a URL to each of said participants so that the URLs are different from each other.

ANALYSIS

Claims 1, 10, 17, and 21 rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

We are persuaded by Appellants' argument that the Specification describes the structures that support the means for performing the claimed functions. Appellants provide citations showing where such support is found and we find such support to be adequate. Reply Br. 13-15.

Claims 1-4, 6, 8-13, and 16-22 rejected under 35 U.S.C. § 103(a) as unpatentable over Strandberg and Wendkos.

As to independent claims 1, 16, and 19-21, none of the references describe sending a first electronic mail to each of said participants, in which the reply electronic mail address is affixed as a unique access key to each of said participants. As to independent claim 17, none of the references

describe uniquely allocating a URL to each of said participants so that the URLs are different from each other.

As to independent claim 10, which merely requires that a unique access key be sent in an email to each recipient and the recipient enter it somehow on some web page, we agree with the Examiner that Strandberg describes this explicitly at paragraph [0019] as "including a unique ID to link to an interested party database record." Ans. 10. Appellants' argument that Strandberg fails to explicitly disclose the unique IDs being different from each other is logically inconsistent. Reply Br. 32. A unique ID by definition distinguishes from every other ID. Claim 18 stands or falls with claim 10.

Dependent claim 11 has a limitation similar to those in claims 1, 16, and 19-21, and Appellants are similarly persuasive with respect to claim 11.

Rejections of claims 8 and 9 under 35 U.S.C. § 103(a) as unpatentable over Strandberg, Wendkos and Sarno and claims 23-26 under 35 U.S.C. § 103(a) as unpatentable over Strandberg, Wendkos and Libby.

These claims depend from independent claims which arguments we found persuasive *supra*.

CONCLUSIONS OF LAW

The rejection of claims 1, 10, 17, and 21 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is improper.

The rejection of claims 1-4, 6, 8, 9, 11-13, 16, 17, and 19-22 under 35 U.S.C. § 103(a) as unpatentable over Strandberg and Wendkos is improper.

The rejection of claims 10 and 18 under 35 U.S.C. § 103(a) as unpatentable over Strandberg and Wendkos is proper.

The rejection of claims 8 and 9 under 35 U.S.C. § 103(a) as unpatentable over Strandberg, Wendkos and Sarno is improper.

The rejection of claims 23-26 under 35 U.S.C. § 103(a) as unpatentable over Strandberg, Wendkos and Libby is improper.

DECISION

The rejection of claims 1-4, 6, 8, 9, 11-13, 16, 17, and 19-26 is reversed.

The rejection of claims 10 and 18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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